

REMARKS

By the present amendment, Applicant has amended independent claims 1 and 20 and has added new dependent claims 38 and 39. Support for the amendments can be found in Applicant's disclosure, for example at paragraphs 0036-0038 of the specification. Upon entry of these amendments, claims 1, 4-18, 20-21, 24-32, 34, and 36-39 will remain pending and under current examination.

I. **Advisory Action of December 19, 2006**

In the December 19, 2006 Advisory Action, the Examiner entered the claim amendments that corrected the minor informalities of claim 34. In particular, the Examiner has: rejected claims 1, 5, 8, 10, 12-18, 20, 21, 26, 28, 29, and 34 under 35 U.S.C. § 102(b) as being anticipated by International Published Application No. WO 97/15009 to Bajpai ("Bajpai"); rejected claims 4, 6, 7, 24, 25, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of International Published Application No. WO 01/18625 A1 to Cha et al., ("Cha"); rejected claims 9 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent Application No. 5,111,384 to Aslanian et al., ("Aslanian"); rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent Application No. 6,877,115 to Herman ("Herman"); and rejected claims 30-32 under 35 U.S.C. § 103(a) as being unpatentable over *Bajpai* in view of U.S. Patent Application No. 6,681,344 to

Andrew ("Andrew"). In addition, all of the rejections from the October 26, 2006 Final Office Action¹ were maintained in the Advisory Action.

II. Examiner Interview of February 13, 2007

Initially, Applicant wishes to thank the Examiner for granting the telephonic interview on February 13, 2007 with Applicant's representative. While no agreement was reached, Applicant has amended independent claims 1 and 20 to further clarify the features of the claimed invention and in a manner that the Examiner indicated may be favorable in overcoming the outstanding rejections. Applicant respectfully requests the Examiner to reconsider the claims and, for the reasons stated below, withdraw all of the rejections.

III. Rejection under 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1, 5, 8, 10, 12-18, 20, 21, 26, 28, 29, and 34 under 35 U.S.C. § 102(b) as being anticipated by *Bajpai*. Applicant respectfully disagrees with the Examiner's arguments and conclusions, and submits that the claims are allowable over the prior art of record.

In order to properly establish anticipation under 35 U.S.C. § 102, the Federal Circuit has held that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131.

Bajpai does not disclose each and every element of Applicant’s claimed invention. For example, *Bajpai* does not disclose a “main system [that] has a client/server configuration with a database, an application server, and a front end server”, and an “auxiliary system [that] uses the client/server configuration of the main system, the client/server configuration enabling the auxiliary system to use functions in the main system for generating the problem related data,” as recited by amended independent claim 1.

The Examiner argues that the “client/server” configuration of the claimed “main system” is shown in Figure 2 of *Bajpai* as the front end, expert system 30, and databases 34, 36, and 38, which are software packages resident on the same computer (see Non-Final Office Action, page 7, line 21 to page 8, line 5). Applicant disagrees. As explained during the telephonic interview of February 13, 2007, the software packages of *Bajpai* that run on the same computer do not constitute “a main system [that] has a client/server configuration”, as required by claim 1. In fact, *Bajpai* does not even disclose or suggest that a client/server configuration is provided with respect to the system of Figure 2 or elsewhere. See the December 1, 2006 Amendment After Final, page 11, line 13 to page 13 line 6 for further arguments.

Even if, *arguendo*, the configuration in Figure 2 includes some form of “client server configuration”, *Bajpai* still does not teach an “auxiliary system [that] uses the

client/server configuration of the main system," as required by independent claim 1 (emphasis added). Instead, as shown in Figure 1 of *Bajpai*, the remote diagnostic system (allegedly the claimed "auxiliary system") uses a modem and separate connection for communicating with the user work station (allegedly the claimed "main system"). It does not use the configuration shown in Figure 2 of *Bajpai* or otherwise use a "client/server configuration of the main system" as required by claim 1. See the December 1, 2006 Amendment After Final, page 13, lines 7-18 for further arguments.

Moreover, *Bajpai* does not teach or suggest "the client/server configuration enabling the auxiliary system to use functions in the main system for generating the problem related data," as further recited by claim 1. Even if *Bajpai* teaches a "client/server configuration" as the Examiner alleges, the configuration of Figure 2 is not disclosed as "enabling the auxiliary system to use functions in the main system" as required by claim 1. In fact, *Bajpai* is completely silent with respect to the ability of the remote diagnostic system (the alleged "auxiliary system") to "use functions" in the user work station (the alleged "main system") for "generating problem related data", as required by claim 1. Accordingly the rejection to claim 1 under 35 U.S.C § 102(b) is improper and should be withdrawn.

Independent claim 20, while differing in scope, contains similar limitations as noted above with respect to claim 1. Accordingly, *Bajpai* also fails to teach each and every element of claim 20, and the rejection under 35 U.S.C § 102(b) of claim 20 should be withdrawn.

Dependent claims 5, 8, 10, 12-18, 21, 26, 28, 29, and 34 depend from claim 1 or 20 and, therefore, require all of the noted elements thereof. As set forth above, *Bajpai*

fails to teach each and every element of base claims 1 and 20. Therefore, for similar reasons, claims 5, 8, 10, 12-18, 21, 26, 28, 29, and 34 are also patentable over the prior art and the rejection under 35 U.S.C. § 102(b) based on *Bajpai* should be withdrawn.

IV. Rejection under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of claims 4, 6, 7, 9, 11, 24, 25, 27, 30-32, 36, and 37 under 35 U.S.C. § 103(a), because no *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143.

Here, no *prima facie* case of obviousness has been established for at least the reason that the cited references fail to teach or suggest each and every element of independent claims 1 and 20, from which the rejected claims depend. This is because *Cha*, *Aslanian*, *Herman*, and *Andrew* fail to cure the noted deficiencies of *Bajpai*. That is, *Cha*, *Aslanian*, *Herman*, and *Andrew*, fail to disclose or suggest a "main system"

having a "client/server configuration" that includes "a database, an application server, and a front end server." Moreover, the cited references fail to teach or suggest an "auxiliary system [that] uses the client/server configuration of the main system, the client/server configuration enabling the auxiliary system to use functions in the main system for generating the problem related data."

Accordingly, *Bajpai, Cha, Aslanian, Herman, and Andrew*, when taken alone or in any proper combination, fail to establish a *prima facie* case obviousness with respect to claims 1 and 20 and, in view of their dependency, claims 4, 6, 7, 9, 11, 24, 25, 27, 30-32, 36, and 37. As such, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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